

REMARKS

Claim Rejections – 35 U.S.C. § 103

Claims 15-16, 19-21, 23, and 26-28 are pending in the present application. In an Office Action mailed June 21, 2004, the Examiner rejects all of the pending claims 15-16, 19-21, 23, and 26-28 of the present application under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,615,188 (Breen et al.). Applicants respectfully traverse the rejections and assert that the claims pending in the present application are patentable over Breen et al. for at least the reasons stated below.

Breen et al. was filed as U.S. Patent Application Number 09/417,901 on October 14, 1999 and issued on September 2, 2003. The present application was filed shortly after the filing date and before the issue date of Breen et al. on December 30, 1999. Accordingly, it appears that the Examiner has qualified Breen et al. as 103(a) prior art under 35 U.S.C. § 102(e). In response, Applicants are submitting herewith a declaration of prior invention under 37 CFR 1.131 to establish a date of invention for the subject matter of the rejected claims (15-16, 19-21, 23, and 26-28), which is prior to the effective filing date of Breen et al., i.e., the actual October 14, 1999 filing date of Breen et al.


As shown with the 1.131 Declaration submitted herewith, the inventors, Stuart Lee Breslow, Alla Turetsky, Robert Kodey, and Todd Commisso, have conceived of and reduced to practice the invention embodiment in the claims pending in the present application prior to the effective filing date of Breen et al. Particularly, at some time no later than December 10, 1998, the inventors conceived the subject matter covered by pending claims 15-16, 19-21, 23, and 26-28 and proceeded with diligence to reduce the claimed invention to practice no later than March 10, 1999, both of which occurred prior to the October 14, 1999 filing of Breen et al.

Conception and reduction to practice are shown with the design documents attached as Exhibits A-F and the Memorandum attached as Exhibit G to the Declaration. The list of the Exhibits outlined in Table A of the Declaration is attached hereto as page 4 of this paper for reference. The location, in the Exhibits, of each of the features of independent claim 15 is outlined in Table B of the Declaration and the location of the features of dependent claims 16, 19-21, 23, and 26-28 is outlined in Table C of the Declaration. It can be seen that all of the features of the pending claims are discussed in the design documents labeled as Exhibits A-E, which are dated between September 10, 1998 and March 10, 1999, thereby establishing

conception of the present invention prior to September 10, 1998, but in any event no later than March 10, 1999, which predates the October 14, 1999 filing date of Breen et al. Indeed, review of the Exhibits shows that the invention was substantially reduced to writing and thus conceived no later than December 10, 1998. With regard to reduction to practice, the Exhibits A-E also include therein screen shots that were taken in connection with tests run periodically during software development to successfully test the operation of the software embodying the invention thereby establishing reduction to practice no later than March 10, 1999. Additionally, Exhibit E refers to a prior demonstration of the software embodying the invention further indicating that the present invention was reduced to practice prior to Exhibit E (March 10, 1999).

Breen et al. therefore, is not prior art insofar as the present invention was conceived and reduced to practice no later than March 10, 1999, as established herein and in the Rule 1.131 Declaration enclosed herewith, which occurred prior to the October 14, 1999 filing date of Breen et al. Accordingly, reconsideration and allowance of pending claims 15-16, 19-21, 23, and 26-28 are therefore respectfully solicited.

Respectfully submitted,

  
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Antonio Papageorgiou,  
Reg. No. 53,431  
BROWN RAYSMAN MILLSTEIN  
FELDER & STEINER LLP  
163 Madison Avenue  
P.O. Box 1989  
Morristown, New Jersey 07962-1989  
Telephone No. 212-895-2905  
Facsimile No. 212-895-2900

I hereby certify that this paper and any accompanying papers referenced herein are being deposited this date with the U.S. Postal Service as First Class Mail with sufficient postage addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

  
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Antonio Papageorgiou

*Nov. 22, 2004*  
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Date

| Document Name  | Date                       | Location and Description   |
|--|----------------------------|--|
| Aged System Rewrite Online Trade Processing Technical Design Document – Document version 1.2 | September 10, 1998         | Exhibit A – Draft document describing the technical design of the online trading engine                          |
| PaineWebber EDGE Trading Release 1.0 Functional Specification – Document version 1.3         | November 2, 1998           | Exhibit B- Provides a functional description of the system   |
| PaineWebber EDGE Trading Release 1.0 Functional Specification – Document version 1.4         | December 10, 1998          | Exhibit C – Provides a functional description of the system  |
| PaineWebber® EDGE Trading <sup>SM</sup> Functional & Business Requirements                   | December 19, 1998          | Exhibit D – Describes the online trading system from a business standpoint                                       |
| Online Trading Processing & EDGE <sup>SM</sup> Online Trading                                | March 10, 1999             | Exhibit E – PowerPoint overview of and demonstration of online trading system                                    |
| Revised Margin Requirements  | No later than July 2, 1999 | Exhibit F – Revision with regard to the margin requirements of Exhibit C   |
| Memorandum Re: Documentation for Online Trading Patent Application                           | July 2, 1999               | Exhibit G – lists documentation forwarded to patent counsel for use in preparing the present patent application. |

Table A – Exhibit Schedule